

REMARKS

Claims 1, 3-5, 7-10, and 12-26 are pending. Claims 5, 7-10, and 12-19 are allowed. Claims 1, 3, 4, 20, 25, and 26 stand rejected. Claims 21-24 stand objected to as being dependent from a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Applicant appreciates the indication of allowance for claims 5, 7-10, and 12-19, and respectfully requests reconsideration and allowance of all claims of this application.

The drawings stand objected to, because reference numeral 25 in Figure 2 is assertedly not as described on page 7. The reference to element 25 has been removed, and the two instances of numeral 25 on Figure 2 have been deleted, as reflected in the above amendment. Also, it is asserted that element 855 is used for two different elements in Figures 4 and 7. Numeral 855 is corrected to numeral 856 in Figure 7 and in reference to Figure 7 on page 9, as reflected in the above amendment.

Claim 20 stands rejected under 35 U.S.C. §102(b) as assertedly anticipated by U.S. Pat. No. 4,607,457 to Shewchuk. Claim 20 has been rewritten to incorporate the language in claim 21, as suggested by the Examiner. Claim 21 has been cancelled. Additional editorial modifications were made to claim 20 for clarification and not for reasons related to patentability.

Claim 25 stands rejected under 35 U.S.C. § 102(b) as assertedly anticipated by U.S. Pat. No. 1,635,920 to Belvin. The Office states "see 'flange' 7, sloping groove 10, door 4, hinges 16 and sloping rib 17."

Applicant respectfully submits that the Office Action has misinterpreted elements described in Belvin '920. Belvin '920 does not disclose every element of present claim 25. Thus, rejection under § 102 is inappropriate.

"To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996). "The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention." *Ex parte Levy*, 17 USPQ2d 1461, 1462 (Bd. Pat. App. & Int. 1990); *see also In re*

Spada, 911 F.2d 705, 708 (Fed. Cir. 1990) (“Rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference.”); *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984) (“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”). “Moreover, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” *Levy* at 1462.

Where there are differences between the referenced disclosure and the claim, a rejection under § 102 is improper. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985). “There must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention.” *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

The “flange 7” of Belvin ‘920 identified by the Office Action is not a flange, but is the entire door frame. Belvin ‘920, page 1, lines 53–54, and Fig. 1. Belvin ‘920 does not disclose a flange having a groove extending along said flange, as claimed in present claim 25.

The “sloping rib 17” of Belvin ‘920 identified by the Office Action does not pivot into the “sloping groove 10” of Belvin ‘920 identified by the Office Action. The recess 10 of Belvin ‘920 is formed in the door frame and receives an integral locking finger 8. Page 1, lines 54–62. Finger 17 of Belvin ‘920 is received in an unspecified recess formed in the door frame, not in a flange as claimed in present claim 25. Page 2, lines 16–18.

There are differences between the invention claimed in claim 25 and Belvin ‘920. Therefore, rejection of claim 25 as anticipated by Belvin ‘920 is improper and Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 1, 3, and 4 stand rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over U.S. Pat. No. 4,906,033 to Sargent et al. The Office Action asserts that Sargent element 42 is a continuous seal and that providing seal 42 in segments to ease installation would have been obvious to one of ordinary skill in the art. The Office Action identifies that upper and side frame members define a U and a bottom frame element is a “threshold.”

The Office Action fails to make a prima facie case of obviousness of claims 1, 3, and 4 in light of the Sargent reference.

The prior art must contain some suggestion or incentive that would have motivated one with skill in the art to modify a prior art reference to arrive at the present invention. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Int., 1986). This is particularly true “in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’ . . . Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak* 175 F.3d 994, 999 (Fed. Cir. 1999) (citations omitted). “The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); *see also In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

The Office Action falls victim to a hindsight-based obviousness analysis in applying the Sargent reference. There is no suggestion or even hint in the prior art to make the modification identified by the Office Action of providing the Sargent seal 42 in segments. The seal 42 “extends continuously around the border of the door member 24 on the inside 28 of the door.” Col. 3, lines 20–22. Applicant respectfully submits that the single continuous seal 42 of Sargent (e.g., column 3, lines 20–22) is to solve the stated problem of weather tightness (column 1, lines 12, 13, 24). Use of a segmented seal in the Sargent apparatus would be more likely to provide openings to defeat the stated purpose of a weather tight seal than the use of the continuous seal 42 as described in Sargent.

Thus, there is no motivation, and the Office Action has not identified any motivation, in the Sargent reference to provide seal 42 in segments. Nor is there any motivation, suggestion, or even hint that doing so would “ease installation,” as set forth in the Office Action. And the Sargent reference does not suggest or hint at any need or desire to ease installation of the seal 42.

In short, the Office Action engaged in unacceptable hindsight reconstruction to make the asserted modifications to the Sargent reference in spite of no motivation, suggestion, or even hint of making such modifications. Thus, the rejection of independent claim 1 under § 103 based on Sargent '033 is improper and Applicant respectfully requests withdrawal of this rejection.

Claim 3 is dependent from claim 1, and is allowable on that basis. Moreover, the Office Action has improperly applied the Sargent reference against claim 3.

The Sargent flange 50, identified in the Office Action as “continuous rib 50,” is not an outwardly extending rib, as claimed in claim 3. On the contrary, Sargent specifically requires that the door frame be “provided with inwardly extending flange” 50. Sargent claim 6; Col. 3, lines 26-27. The flange 50 in Sargent extends inwardly from the frame *away from the door* 24. *See, e.g.,* Sargent Fig. 6. The rib 35 of the present invention extends outwardly from the frame *toward the door*. *See, e.g.,* Fig. 6 of the present application. Thus, Sargent does not disclose the “outwardly extending rib” as claimed in claim 3 of the present application. In direct contrast to claim 3 of the present application, the Sargent reference discloses an inwardly extending flange. It would not be obvious to provide the rib 35 of Sargent with the exact opposite orientation.

Claim 4 is dependent from claim 1, and is allowable on that basis. Moreover, the Office Action has improperly applied the Sargent reference against claim 4.

Claim 4 recites “a generally U-shaped member having an open lower end and . . . a threshold that bridges said open lower end of said U-shaped member.” The Office Action asserts that upper and side frame members of Sargent “define a U and the bottom frame element is a “threshold.” Considering the Sargent et al. structure to have an open lower end and a threshold bridging that open lower end is contrary to the discussion of the frame 16 in the written description in that patent. The frame 16 is “a rectangular frame 16,” column 2, line 63, and “provided with a rectangular access opening 18.” Column 2, lines 63–64. The frame 16 does *not* have an open lower end, as claimed in claim 4 of the present application. Nor is there any structure that bridges a non-existent open lower end, as claimed in claim 4 of the present application. On the contrary, the frame 16 of Sargent is *continuous*, with no open ends. *See, e.g.,* Sargent Figure 2.

Appl. No. 09/978,409
Amdt. Dated September 17, 2004
Reply to Office Action of April 19, 2004

Sargent does not teach, suggest, or even discuss the possibility that the frame 16 has an open end. Again, the Office Action has fallen victim to the hindsight analysis against which the Court of Appeals for the Federal Circuit has cautioned. Sargent does not disclose, suggest, or even hint at an open lower end. And there is no motivation to make such a modification to the frame in Sargent.

In view of the above remarks, it is submitted that claims 1, 3-5, 7-10, and 12-20, and 22-26 are in condition for allowance. Prompt notice of such allowance is respectfully requested.

Respectfully submitted,

CALFEE, HALTER & GRISWOLD LLP

Date: 9/17/04

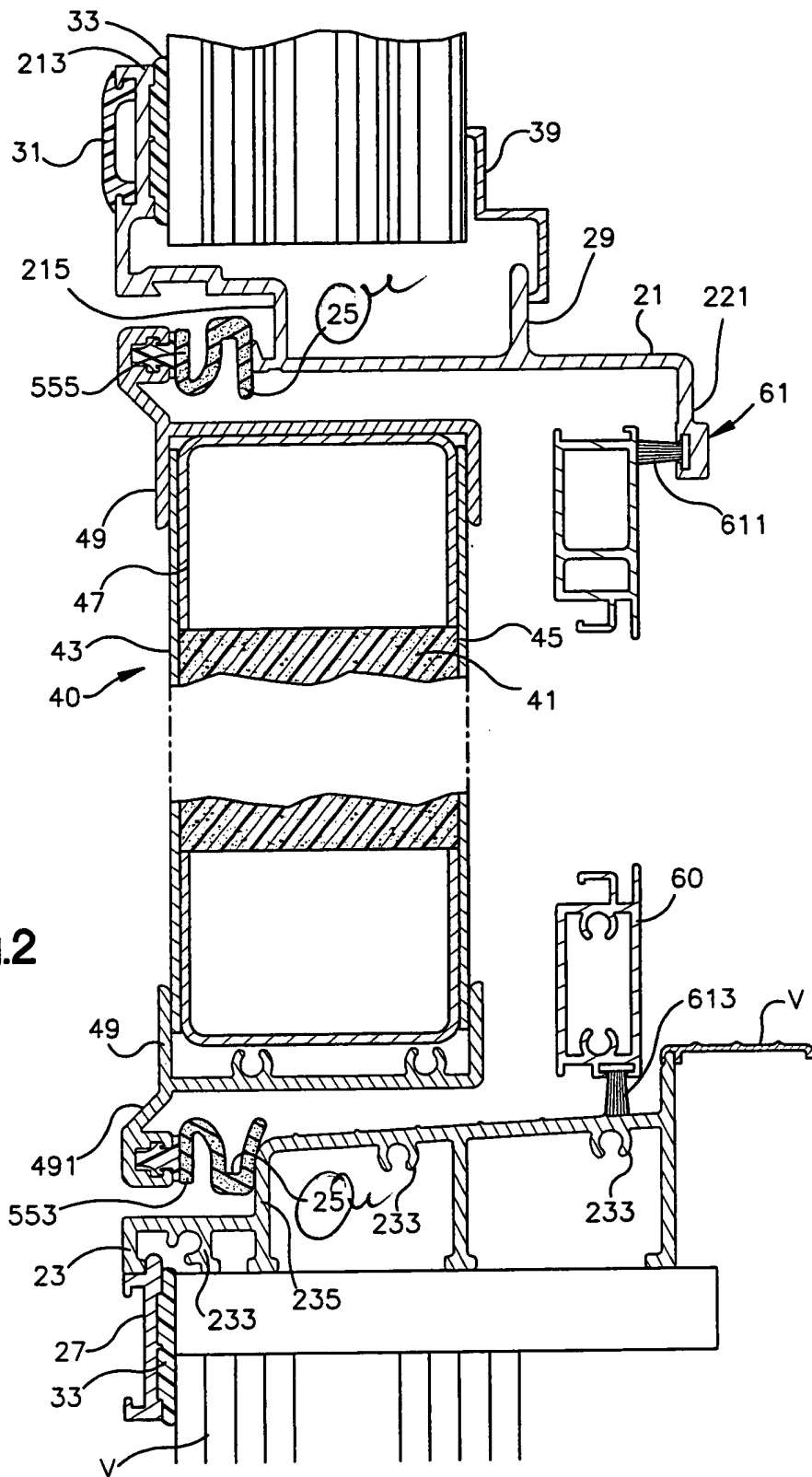
By: 

Warren M. Haines II
Reg. No. 40,632
Telephone (216) 622-8477

Appl. No. 09/978,409
Amdt. Dated September 17, 2004
Reply to Office Action of April 19, 2004

Amendments to the Drawings

The attached sheets of drawings include changes to Figures 2 and 7. The first replacement sheet, which includes Figure 2, replaces the original sheet including Figure 2. Figure 2 has been amended to delete two instances of reference numeral 25. The second replacement sheet includes Figures 7, 8A, and 8B and corrects numeral 855 in Figure 7 to numeral 856.



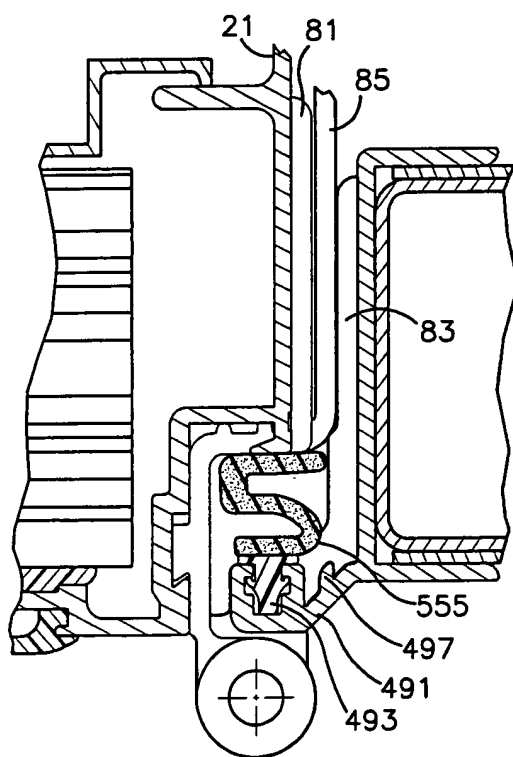
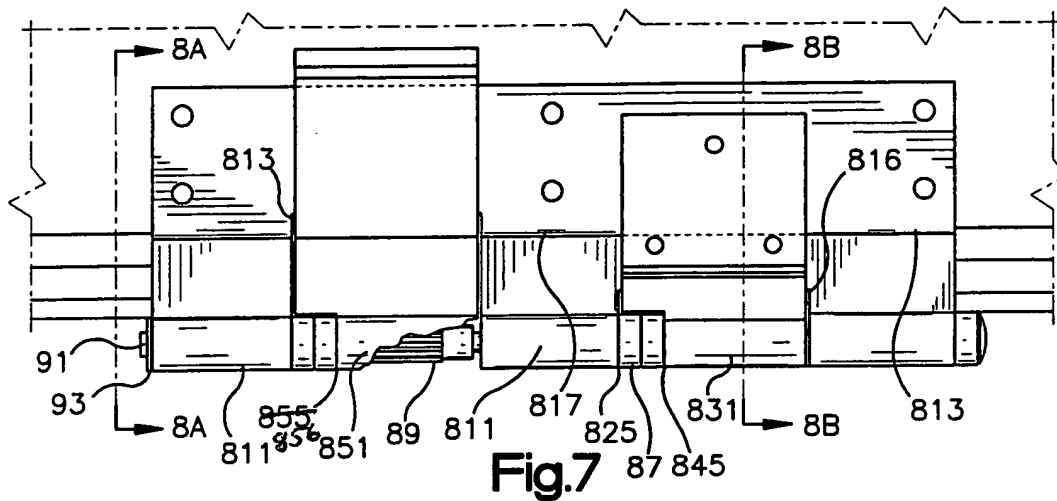


Fig.8A

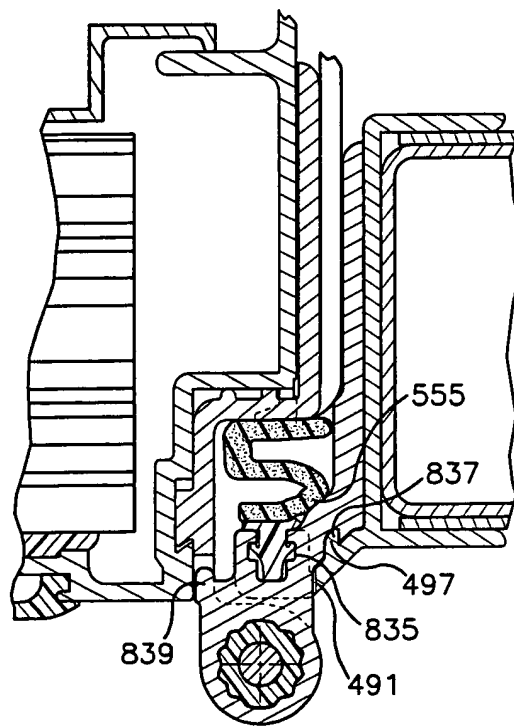


Fig.8B